

REMARKS

Restriction has been required under 35 USC 121 and 372 from among three (3) identified claims groups, which are:

- 1) Claims 1-20, 31 and 32, drawn to a method of preparing DNA fragments (Group I);
- 2) Claims 21-24 and 33-35, drawn to a DNA fragment (Group II); and
- 3) Claims 27 and 36, drawn to a method of hybridizing nucleic acids (Group III).

The above claim groups are said to not relate to a ‘single general inventive concept’ under PCT Rule 13.1, because under PCT Rule 13.2 they lack the same or corresponding special technical feature inasmuch as Dunn et al¹ (at page 1757, Figure 1) is said to “teach a short DNA fragment as broadly claimed.” See page 2 of the Restriction Requirement.

However, no effort has been made by the examiner to explain how Dunn et al discloses the DNA fragment of claim 21. It is clear from the Verisign² case that in attempting to show that a reference discloses a claimed invention, it is incumbent upon the examiner to show how the reference discloses not only what is claimed, but the order in which it is claimed. In the present case, the examiner has made no effort to show how Dunn et al discloses, for example:

- 1) A nucleotide sequence of less than 100 base pairs;
- 2) Containing at least one specific sequence of a fragment of a genomic sequence or of a cDNA sequence;
- 3) Bordered, respectively, by the recognition site and the cleavage site of which is located downstream of the recognition site;

1 “Genomic Signature Tags (GSTs): A System for Profiling Genomic DNA,” John J. Dunn et al., XP-002304617, Genome Research, March 28, 2002, pp. 1756-1765.

2 Net Money In, Inc. v. Verisign, Inc. et al, 545 F.3d1359 (Fed.Cir.2008)

- 4) Such that the 5' end of the specific sequence corresponds to the last x base pairs of the recognition site; and
- 5) Having N base pairs of the enzyme E2, with $1 \leq x \leq N-1$, the marker including at least 6 bases or 6 base pairs of nonspecific sequence.

Hence, no adequate showing of lack of novelty has been made by the examiner. Further, no showing has been made by the examiner why Dunn et al would have rendered the DNA fragment of claim 21 (in Group II) obvious to one skilled in the art at the time the claimed invention was made.

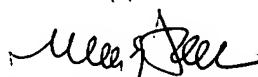
Hence, this basis for requiring restriction is unwarranted and should be withdrawn.

Moreover, Applicants are mindful of MPEP 803, which requires that a search and examination of all aspects of a claimed invention be searched and examined unless to do so would constitute a "serious burden."

In the present case, the examiner has made no effort to establish such a serious burden. For example, no tally of search classes and subclasses has been offered from which the requisite serious burden might be inferred.

Hence, for this additional reason, the requirement for restriction is unwarranted and should be withdrawn.

Respectfully submitted,
THE NATH LAW GROUP



William E. Beaumont, Reg. No. 30,996
Customer No. 20529

Date: April 16, 2009
THE NATH LAW GROUP
112 S. West Street
Alexandria, Virginia 22314
Tel: (703) 548-6284
Fax: (703) 683-8396
WEB/get